Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL C. ADDISON
and MICHAEL A.J. MOSS

Appeal No. 1998-0762
Application No. 08/379,576

ON BRIEF

Before PAK, WALTZ, and PAWLIKOWSKI, Administrative Patent Judges.

PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 through 20, which are all of the claims pending in the above-identified application.

APPEALED SUBJECT MATTER

The subject matter on appeal is directed to laundry detergent compositions. Claim 1 is illustrative of the subject matter on appeal and reads as follows:

1. A laundry detergent composition comprising

(a) from 7% to 20% by weight of a crystalline layered silicate builder material of formula $LMSi_xO_{2x+1}\cdot yH_2O$ wherein L is an alkali metal, and M is sodium or hydrogen, x is a number from 1.9 to 4 and y is a number from 0 to 20;

(b) from 3% to 40% by weight of an alkali metal percarbonate bleach; and

(c) from 0.05% to 10% by weight of ethylenediamine -N, N'- disuccinic acid, or alkali metal, alkaline earth, ammonium or substituted ammonium salts thereof, or mixtures thereof.

PRIOR ART

In support of his rejections, the examiner relies on the following prior art references:

Gray	4,664,837	May 12, 1987

Hartman et al. (Hartman)	4,704,233	Nov. 3, 1987
Dany et al. (Dany ‘415)	5,066,415 (Filed Aug. 24, 1990)	Nov. 19, 1991
Dany et al. (Dany ‘895)	5,078,895 (Filed Dec. 13, 1990)	Jan. 7, 1992
Painter et al. (Painter) (Published PCT International Application)	WO 92/09680	Jun. 11, 1992

REJECTION

The appealed claims stand rejected or provisionally rejected as follows:

1) Claims 1, 2, 4 through 14, 16 through 18 and 20 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Dany ‘415, Dany ‘895, and Painter;

2) Claim 3 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Dany ‘415, Dany ‘895, Painter and Hartman;

3) Claims 15 and 19 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Dany ‘415, Dany ‘895, Painter and Gray; and

4) Claims 1 through 20 under the judicially created doctrine of double patenting as unpatentable over claims 1 through 5 and 8 through 23 of Application 08/379,577.

OPINION

We have carefully reviewed the claims, specification and applied prior art, including all of the arguments advanced by both the examiner and appellants in support of their respective positions. This review leads us to conclude that only the examiner's aforementioned § 103 rejections of claim 1 through 5 and 9 through 20 are well founded. Thus, we affirm only the examiner's aforementioned § 103 rejections of claims 1 through 5 and 9 through 20. However, since our affirmance relies on evidence and rationale materially different from those proffered by the examiner, we denominate our affirmance as including new grounds of rejections under 37 CFR § 1.196(b). Our reasons for this determination follow.

SECTION 103 REJECTIONS

We first consider the examiner's § 103 rejection of claims 1, 2, 4 through 14, 16 through 18 and 20 over the combined disclosures of Dany '895, Dany '415 and Painter. We find that Dany '895 discloses a laundry detergent composition

comprising 10 to 50% by weight of a crystalline layered silicate as a builder, 1 to 5% by weight of tetraacetylethylenediamine (TAED) and 0.5 to 4% by weight of a bleach, such as sodium perborate and/or sodium percarbonate. See column 1, lines 47-57 and abstract. There is no dispute that Dany '895 describes the claimed crystalline layered silicate and bleach (percarbonate)[1] Compare the Answer in its entirety with Brief in its entirety. As argued by appellants at page 7 of the Brief, we recognize "Dany '895 [by itself] provides no teaching or suggestion relating to the use of EDDS [ethylenediamine-N, N'-disuccinic acid] in [its] disclosed composition." However, we find that Painter describes using various conventional chelants, including TAED and EDDS, in a dishwashing composition comprising a builder and an oxygen bleach system. See page 1, lines 6-13, page 8, line 30 to page 9, line 28. We find that Painter prefers a non-phosphorous chelant, EDDS, described in U.S. Patent 4,704,233 issued to Hartman et al. since this chelant is "believed to

[1] According to appellants (Specification, pages 1 and 2), the claimed crystalline layered silicate and the claimed sodium percarbonate are also known to be advantageous as a detergent builder material and a bleach, respectively.

have attractive characteristics from the viewpoint of the environment...". See page 9. Hartman et al[2] referred to in Painter is directed to employing EDDS as a preferred chelant for a laundry detergent composition. Thus, it can be inferred from the teachings of both Painter and Dany '895 that chelants, such as EDDS and TAED, are useful for both laundry or dish-washing detergent compositions. Indeed, appellants acknowledge that a well known chelant, EDDS, is known to be useful for replacing all or part of a conventional chelant already employed in a laundry composition and useful for removing food, beverage and certain organic stains. See Specification, page 1.

Given the recognition of the advantage of partly or fully replacing the conventional chelant in a laundry detergent composition with EDDS, one of ordinary skill in the art would have been led to employ EDDS to partly or fully replace TAED in the laundry detergent composition described in Dany '895, with a reasonable expectation of successfully imparting

[2] Hartman et al. is the same reference the examiner relies on to reject claim 3.

environmentally safe and effective food, beverage and other organic stain removing properties.

Appellants separately argue that the use of a solid peroxyacid precursor, such as TAED, as required by claims 13, 14, 17 and 18, is not taught or suggested in either Dany ‘895 or Painter. However, we are not persuaded by this argument for the reasons indicated *supra*.

Appellants also separately argue that the specific anionic and nonionic surfactants recited in claims 6, 7 and 8 are not taught or suggested by the applied prior art references. We agree with appellants to the extent that the applied prior art references by themselves do not teach, nor would have suggested, the claimed specific anionic or nonionic surfactants. We also observe that the examiner has not referred to any teaching or suggestion provided in the applied prior art references regarding the claimed specific anionic and nonionic surfactants. See Answer in its entirety.

In view of the foregoing, we affirm the examiner’s § 103 rejection of claims 1, 2, 4, 5, 9 through 14, 16 through 18 and 20, but reverse the examiner’s § 103 rejection of claims

6, 7 and 8, over the combined disclosures of Dany ‘895, Dany ‘415 and Painter.

We consider next the examiner’s § 103 rejection of claim 3 over the disclosure of Hartman in addition to the Dany and Painter disclosures indicated above. Claim 3 limits the EDDS (in acid, or alkali, alkaline earth, ammonium or substituted ammonium salts thereof or mixtures thereof) recited in claim 1 to magnesium salt of EDDS. As indicated above, we find that Hartman is already part of the Painter disclosure. We also find that Hartman teaches the importance of using EDDS in acid, alkali, alkaline earth, ammonium or substituted ammonium salts thereof, or mixtures thereof in a laundry composition containing a detergent builder, and anionic and nonionic surfactants. See column 3, lines 10-27. Since the magnesium salt of EDDS is one of the limited salt forms described in Hartman, we agree with the examiner that it would have been obvious to employ the magnesium salt of EDDS as the chelant of the laundry composition described in Dany ‘895 as indicated *supra*. *See also Merck & Co. v. Biocraft Laboratories Inc.*, 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir.), *cert.*

denied, 493 U.S. 975 (1989); *In re Petering*, 301 F.2d 676, 682, 133 USPQ 275, 280 (CCPA 1962).

In view of the foregoing, we affirm the examiner's § 103 rejection of claim 3 as unpatentable over the combined disclosures of Dany '895, Dany '415, Painter and Hartman.

We consider next the examiner's § 103 rejection of claims 15 and 19 over the combined disclosures of Dany '895, Dany '415, Painter and Gray. Claims 15 and 19 require a second peroxy bleach, an organic peroxyacid bleach. Appellants do not dispute the examiner's finding that "Gray shows that it is conventional to use the recited amount of an organic peroxyacid in combination with oxygens [sic, oxygen] bleaches such as percarbonates in bleaching and detergent compositions..." Compare Answer, page 5 with Brief, page 14 and Reply Briefs in their entirety. Nor do appellant dispute that it would have been obvious to include such organic peroxyacid bleach in the laundry detergent composition described in Dany '895. See Brief, page 14 and Reply Briefs in their entirety.

Appellants only argue that "rather than teaching the combination of EDDS and an organic peroxyacid, Painter et al.,

at most, teaches that EDDS and peroxy acid are alternate ingredients...," thus teaching away from the claimed laundry detergent composition. See Brief, pages 13 and 14. However, we find that appellants' argument is not persuasive for at least two reasons. First, contrary to appellants' argument, nowhere does Painter foreclose using an organic peroxyacid together with EDDS. Secondly, appellants' argument does not focus on the combined teachings of the applied prior art. From our perspective, the combined teachings of the applied prior art references would have suggested the inclusion of more than one peroxy bleaching agents, including an organic peroxyacid, in the laundry detergent composition of the type suggested by the applied prior art references within the meaning of 35 U.S.C. § 103.

In view of the foregoing, we affirm the examiner's § 103 rejection of claims 15 and 19 as unpatentable over the combined disclosures of Dany '895, Dany '415, Painter and Gray.

OBVIOUSNESS-TYPE DOUBLE PATENTING

We consider next the examiner's provisional rejection of claims 1 through 20 "under the judicially created doctrine of

[obviousness-type] double patenting over claims 1-5 and 8-23 of copending Application No. 08/379,577." See Answer, page 6. This rejection is moot since Application 08/379,577 is no longer pending.

REMAND TO THE EXAMINER

We remand the application to the examiner to take appropriate action. As indicated *supra*, Dany '895 does not teach the claimed anionic and nonionic surfactants recited in claims 6 through 8. However, we observe that Dany '895 generically teaches using anionic and nonionic surfactants in its laundry detergent composition. See column 3, Table 1. Although Dany '895 does not specify the types of anionic and nonionic surfactants employed, appellants appear to acknowledge that U.S. Patent 3,929,678 issued to Laughlin et al. teaches that the claimed anionic and nonionic surfactants are useful as the surfactants of laundry detergent compositions (Specification, page 10). Upon return of this application, the examiner shall review the content of this patent and determine whether the combined teachings of this patent, Dany '895, Painter and Hartman would have suggested

the laundry detergent compositions recited in claims 6 through 8 within the meaning of 35 U.S.C. § 103.

CONCLUSION

In summary:

1) The examiner's § 103 rejection of claims 1, 2, 4, 5, 9 through 14, 16 through 18 and 20 over the combined disclosures of Dany '895, Dany '415 and Painter is affirmed;

2) The examiner's § 103 rejection of claims 6 through 8 over the combined disclosures of Dany '895, Dany '415 and Painter is reversed;

3) The examiner's § 103 rejection of claim 3 over the combined disclosures of Dany '895, Dany '415, Painter and Hartman is affirmed;

4) The examiner's § 103 rejection of claims 15 and 19 over the combined disclosures of Dany '895, Dany '415, Painter and Gray is affirmed; and

5) The examiner's rejection of claims 1 through 20 under the judicially created doctrine of obviousness-type double

patenting over claims 1 through 5 and 8 through 23 of Application 08/379,577 is moot; and

6) The application is remanded to the examiner to review the content of the prior art, U.S. Patent 3,929,678, cited at page 10 of the specification and determine whether this patent, together with Dany ‘895, Painter and Hartman, affects the patentability of the subject matter recited in claims 6 through 8.

Accordingly, the decision of the examiner is affirmed-in-part and the application is remanded to the examiner for appropriate action consistent with the above instruction. With respect to our affirmance, it is denominated as including new grounds of rejection in accordance with 37 CFR § 1.196(b) since it relies on rationale and evidence materially different from those proffered by the examiner. In the event of further prosecution, the examiner should refer to appellants’ admission relied upon by the Board, but not Dany ‘415 (not relied upon by the Board), in the statement of rejections.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203

Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
>
> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

This application, by virtue of its "special status", requires an immediate action, MPEP &708.01 (7th ed., July 1998). It is important tht the board by promptly informed of any action affecting the appeal in this case.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART/(196(b))/REMANDED

CHUNG K. PAK Administrative Patent Judge	)	
THOMAS A. WALTZ Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
BEVERLY A. PAWLIKOWSKI Administrative Patent Judge	)	

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Appeal No. 1998-0762
Application No. 08/379,576

APJ PAK

APJ WALTZ

APJ PAWLIKOWSKI

DECISION: AFFIRMED-IN-PART/(196(b))/REMAND
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s):

Prepared: June 21, 2002

Draft Final

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OB/HD GAU

PALM / ACTS 2 / BOOK
DISK (FOIA) / REPORT